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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOLGER LISTLE and ANDRE BARKOWSKI

Appeal 2007-2605
Application 10/600,894
Technology Center 3600

Decided: June 25, 2008

Before JENNIFER D. BAHR, LINDA E. HORNER, and
DAVID B. WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

STATEMENT OF THE CASE

The Appellants seek our review of the Examiner's final rejection of claims 15-18 under 35 USC § 134 (2002). We have jurisdiction under 35 USC § 6(b) (2002). We affirm.

The Appellants claim a driver information device for replacing symbols for multiple objects located in one place on a map with an indicator symbol representing all of them. The user can select this indicator symbol to

generate a display of symbols, as well as a description of the special objects in a selection menu (Specification 1:19-24). Claim 15, reproduced below, is representative of the subject matter on appeal.

15. A driver information device comprising:
- a map display, special objects being represented on the map display by special object symbols, a common indicator symbol in the map display indicating a presence of corresponding multiple special objects one of
 - (a) in one location and
 - (b) within a preselected radius of a location,
 - a selection of the common indicator symbol enabling a display of a selection menu containing information about the corresponding multiple special objects, wherein the selection menu is displayed on the map display;
 - wherein during the display of the selection menu, the common indicator symbol is displayable at a same location on the map where it was displayed before the display of the selection menu, embedded in the selection menu.

THE REJECTION

The Examiner relies upon the following as evidence in support of the rejections:

Miyaki	US 2002/0130906 A1	Sep. 19, 2002
Shmueli	US 2002/0145632 A1	Oct. 10, 2002

Noble	US 2003/0085910 A1	May 8, 2003
Yokota	US 6,640,185 B2	Oct. 28, 2003

Claims 15-18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Miyaki in view of Noble and further in view of Yokota and Shmueli.

ISSUE

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 15-18 under 35 USC § 103(a) as unpatentable over Miyaki in view of Noble and further in view of Yokota and Shmueli. More particularly, the issue is whether the improvement claimed by Appellants is more than the predictable use of prior art elements according to their established functions.

FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Miyaki teaches (in the Background of the Invention) a point of interest icon display method for displaying icons at the location of a point of interest (POI) on a map. POIs include ATMs, banks, gas stations, restaurants, hotels, parking lots, etc. The navigation

apparatus displays POI facilities having large premises, such as parks, hospitals, and factories using polygons and displays within the polygon a POI icon indicating the category of the POI along the road. When the POI icon is pointed to by a cursor and the enter key is pressed, the navigation apparatus displays detailed information about the selected POI (Miyaki, 1:[0003-0004]).

2. An object of Miyaki is to make it easy to see roads on a map by reducing the number of POI icons displayed on the map. According to Miyaki, this can be achieved by a POI icon display method comprising the steps of: (1) displaying one representative icon when POI icons overlap or when POI icons are densely distributed; and (2) displaying the original individual POI icons when the representative icon is selected (Miyaki, 1:[0005] & [0007]). When a predetermined multiple-icon icon is selected using the cursor, the navigation apparatus displays the original individual POI icons instead of the multiple-icon icon, or displays the detailed information (name, address, telephone number, etc.) of the POIs corresponding to the original individual POI icons in such a manner as to overlap the map (Miyaki, 3:[0045]).
3. Yokota teaches that when a user wants to know more about the POIs under a cursor marker, the user presses the enter key and the navigation system moves to a break down menu in a name list screen. When a particular POI is selected, the name of the POI is

shown and an information box shows more detailed information about the selected POI, such as address, phone number, direction, and distance from the current vehicle position (Yokota, col. 14, ll. 11-21).

4. Noble teaches the use of 1) normal map display symbols that identify a single entity without an underlying hierarchy; 2) cluttered map display symbols which are a plurality of normal map signals in close proximity, touching, or overlapping each other; and 3) de-cluttered map display symbols, wherein a single de-cluttered symbol replaces and represents a plurality of cluttered symbols at one level of hierarchy. Examples of de-cluttered map display symbols include a single de-cluttered aircraft symbol replacing three cluttered aircraft symbols and a de-cluttered hierarchical symbol representing an infantry brigade, which is known to consist of six underlying infantry company symbols or two underlying infantry battalion symbols (Noble, 2:[0018] and [0021]).
5. Noble also teaches that when either 1) a group of cluttered map display symbols; or 2) a de-cluttered map display symbol is selected by a pointing device with the map display region, the symbol expansion system can provide a tabular symbol expansion display that includes symbol expansion graphics, symbol expansion data, and a lead line. The symbol expansion graphics 62

and the symbol expansion data 64 correspond to record graphics and record data of map symbol record group 36 (Noble. 3:[0029 & 0030]). Figure 2 of Noble shows the simultaneous display of cluttered symbols within a selected map display region and a symbol expansion display corresponding to the cluttered symbols and providing a means by which a person viewing the computer map display can resolve the information of the cluttered symbols (Noble, 4:[0042]).

6. Shmueli is directed to a portable interface for computing. A launching bar includes a launch button which may be configured to provide a function menu including a selection for "My Bookmark", "E-Cart", and "E-Wallet." The Launching bar may provide a user interface to the functions provided by a key as well as the fixed advertising information or select advertising information independent of the web page selected by the user (Shmueli, 5:[0053]).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of

underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of ordinary skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in

the same way, using the technique is obvious
unless its actual application is beyond his or her
skill.

Id. at 1740. The operative question in this “functional approach” is thus
“whether the improvement is more than the predictable use of prior art
elements according to their established functions.” *Id.*

The Supreme Court stated that “[f]ollowing these principles may be
more difficult in other cases than it is here because the claimed subject
matter may involve more than the simple substitution of one known element
for another or the mere application of a known technique to a piece of prior
art ready for the improvement.” *Id.* The Court explained, “[o]ften, it will be
necessary for a court to look to interrelated teachings of multiple patents; the
effects of demands known to the design community or present in the
marketplace; and the background knowledge possessed by a person having
ordinary skill in the art, all in order to determine whether there was an
apparent reason to combine the known elements in the fashion claimed by
the patent at issue.” *Id.* at 1740-41. The Court noted that “[t]o facilitate
review, this analysis should be made explicit.” *Id.* (citing *In re Kahn*, 441
F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds
cannot be sustained by mere conclusory statements; instead, there must be
some articulated reasoning with some rational underpinning to support the
legal conclusion of obviousness”)). However, “the analysis need not seek
out precise teachings directed to the specific subject matter of the challenged

claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

ANALYSIS

Appellants argue claims 15-18 as a group. We therefore treat claim 15, the only independent claim as representative.

The Examiner found that Miyaki does not explicitly disclose that the menu should be a selection menu and the selection is displayed on the map display, but Miyaki does teach superimposing a menu on the map. The Examiner further found that Noble teaches displaying the indicator symbol 102 and menu 106 at the same location on the map with details arranged in menu 106 (Answer 3, citing Noble, fig. 2 and para. 0042). According to the Examiner, arranging the details taught by Noble in menu format would have been taught by Yokota in which selectable menu 120-122 are displayed (*Id.*,

citing Yokota, fig. 12B). The Examiner also found that Noble teaches displaying selection symbol 102 in the same location on the display and Shmueli teaches displaying a selection menu 88-92 with a symbol 86 displayable at the same location on the display and embedded in the selection menu (*Id.*, citing Noble, fig. 2, Shmueli, fig. 6). The Examiner therefore found that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display the menu taught by Miyaki as [a] selectable menu as taught by Yokota and to display the menu embedding the symbol at the same location on the map as taught by the combined teaching of Noble and Shmueli in order to allow the user to obtain more information on an interested point of interest at the area the point of interest is located” (*Id.*).

The Appellants argue that there is no reasonable interpretation of claim 15, particularly when read in light of the present specification, that would support the Examiner’s contention that a manual repositioning of the menu locations is something that is encompassed by the claimed feature (Reply Br. 5). We disagree. We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

Giving claim 15 its broadest reasonable interpretation in light of the Specification, we find that the term “displayable” does not require that the common indicator actually be displayed at the same location where it was displayed before the display of the selection menu, embedded in the selection menu, but merely that it be capable of being so displayed. We note that Miyaki teaches displaying the detailed information (name, address, telephone number, etc.) of the POIs corresponding to the original individual POI icons in such a manner as to overlap the map (Finding of Fact 2). Miyaki places no limitation on where that display may overlap the map, at least making it possible that the representative icon may be embedded in the display of detailed information. Moreover, we agree with the Examiner that

by using [the] map display features taught by Noble the user can obtain the result “displaying the menu with the common indicator at the same location on the map where it was displayed” by just simply mov[ing] the menu location because in claim 11 Noble discloses that the list of the symbol expansion graphics (the menu or the tabular list 106 (fig.2)) are “movable by the user” (Noble lines 2-3 of claim 11); therefore, from claim 11 taught by Noble, it is obvious that the user can move the menu to anywhere he prefers on the map display including moving the menu onto the common indicator 102 (fig.6)

(Answer 7-8). We therefore find that the combination of Noble with Miyaki is capable of displaying the common indicator at the same location where it

was displayed before the display of the selection menu, embedded in the selection menu.

The Appellants argue that the Examiner's stated rationale for making the asserted combination of the specific teachings of the applied references is clearly inadequate to support the asserted combination (Br. 5). In particular, Appellants argue that it is simply unreasonable to suggest that one of ordinary skill in the art, without knowing anything about Appellants' claimed invention, would actually be motivated to specifically pick out the selected parts of each of the applied references and combine the selected parts in the exact manner asserted by the Examiner (Br. 6). Appellants further note that the Examiner provides no rationale for why one of ordinary skill in the art would combine the teachings of Noble and Shmueli (*Id.*). The Appellants also argue that the Examiner provides no actual suggestion in the applied prior art to make the asserted combination (Br. 7). To the extent the Appellants argue in their pre-*KSR* Brief that there is no explicit teaching, suggestion, or motivation to combine Miyaki with Noble, Yokota, and Shmueli, that argument is foreclosed by *KSR*. *KSR*, 127 S.Ct. at 1740-41.

Appellants also argue that Miyaki and Yokota each teach away from the combination of references asserted by the Examiner. In particular, Appellants assert that Miyaki teaches away from showing the common indicator symbol at the same place in the map and embedded in the selection menu, essentially because the two specific embodiments of Miyaki do not show this feature (Br. 7). The Appellants further argue that Yokota also

teaches away from the Examiner's asserted combination, because only a selection menu is shown instead of a map (Br. 8). The Appellants have provided no persuasive evidence to show that the absence of the respective features from these individual references would teach away from the combination of Miyaki or Yokota with the other asserted references, which in combination teach the missing limitations. Further, Appellants' argument appears to attack Miyaki and Yokota individually, rather than the combination of Miyaki, Yokota, Noble, and Shmueli proposed by the Examiner. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

One of ordinary skill in the art would have been able to modify Miyaki to display the menu taught by Miyaki as a selectable menu as taught by Yokota, and to move that menu as taught by Noble using methods known in the art at the time the invention was made. Moreover, each of the elements of Miyaki, Noble, Yokota, and Shmueli combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. *See Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976).

Thus, Claim 15 is a combination which only unites old elements with no change in their respective functions and which yields predictable results. Therefore, the claimed subject matter likely would have been obvious under

KSR. In addition, neither Appellants' Specification nor Appellants' arguments present persuasive evidence that modification of Miyaki as suggested by the Examiner is uniquely challenging or difficult for one of ordinary skill in the art. Moreover, the selectable menu of Yokota and moving a menu as taught by Noble are techniques that have been used to improve their respective devices, and one of ordinary skill in the art would recognize that they would improve similar devices in the same manner.

Because Appellants have not shown that the application of the selectable menu of Yokota or the movable menu of Noble to Miyaki would have been beyond the skill of one of ordinary skill in the art, we find using those techniques to modify Miyaki would have been obvious. Under those circumstances, the Appellants have not shown error in the Examiner's rejection of claim 15. Claims 16-18 were not argued separately, and fall with claim 15. See 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

STATEMENT PURSUANT TO 37 C.F.R. § 41.50(C)

Pursuant to 37 C.F.R. § 41.50(c)¹, we point out that the rejection of claims 15-18 as unpatentable over Miyaki in view of Noble and further in

¹ 37 C.F.R. § 41.50(c) states that the opinion of the Board may include an explicit statement of how a claim on appeal may be amended to overcome a specific rejection, and the Appellants have the right to amend in conformity therewith. The Examiner will enter the proposed amendment after termination of the appeal proceedings.

view of Yokota and Shmueli, sustained herein for the reasons discussed above, may be overcome by amending the “wherein” step of independent claim 1 to read, “wherein during the display of the selection menu, the common indicator symbol is *displayed* at a same location on the map where it was displayed before the display of the selection menu, embedded in the selection menu.”

CONCLUSION

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 15-18 under 35 USC § 103(a).

DECISION

The decision of the Examiner to reject claims 15-18 under 35 USC § 103(a) is affirmed. A statement under 37 C.F.R. § 41.50(c) as to how independent claim 15 may be amended to overcome the rejection of claims 15-18 is included in this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED; 37 C.F.R. § 41.50(c)

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